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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,496	01/28/2000	Adam L. Cohen	06666/010005/2613	2322

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EXAMINER

WONG, EDNA

ART UNIT PAPER NUMBER

1753

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/493,496

Applicant(s)

COHEN, ADAM L.

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7 and 8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

This is in response to the Amendment dated September 8, 2003. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Rejections - 35 USC § 102

Claims **7 and 9** have been rejected under 35 U.S.C. 102(b) as being anticipated by **Trueba** (US Patent No. 5,560,837).

The rejection of claims 7 and 9 under 35 U.S.C. 102(b) as being anticipated by Trueba has been withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 103

Claim **8** has been rejected under 35 U.S.C. 103(a) as being unpatentable over **Trueba** (US Patent No. 5,560,837) as applied to claims 7 and 9 above.

The rejection of claim 8 under 35 U.S.C. 103(a) as being unpatentable over Trueba as applied to claims 7 and 9 above has been withdrawn in view of Applicant's amendment.

Response to Amendment

Drawings

The drawings were received on July 31, 2003. These drawings are approved by

the Examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Vanlseghem** (US Patent No. 4,764,449) in combination with **Ehrlich** (US Patent No. 5,874,011).

Vanlseghem teaches a method of making a supported mask that may be used in modifying a substrate, comprising the steps of:

(a) obtaining a support **45** (= support membrane) that is not the substrate **43** (= wine goblet) [col. 8, lines 8-26];

(b) applying at least one layer of dielectric material **44** (= resist layer) to said support (col. 3, line 61 to col. 8, line 5); and

(c) exposing said layer to etching to substantially cause removal of said layer from said support in exposed areas **45** (= the revealed support membrane),

wherein the exposing step causes ablating (= abrading) of the exposed areas of the layer (= the revealed support membrane **45** is etched, abrading the membrane and the underlying surface, leaving a desired pattern **47**) [col. 3, lines 32-41; col. 10, lines

20-39; and Fig. 4).

Vanlseghem does not teach wherein the removal of said layer is caused by patterned light; and wherein the patterned light is UV light.

However, Ehrlich teaches the removal of a layer by laser etching (col. 9, lines 1-45; and Fig. 7). The laser wavelength is in the ultraviolet region (col. 5, lines 1-25).

Thus, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made because one skilled in the art would have been motivated to have modified the method of Vanlseghem with wherein the removal of said layer is caused by patterned light; and wherein the patterned light is UV light because laser etching would have been doing the same endeavor of removing the layer from the support in the exposed areas as taught by Ehrlich (col. 9, lines 1-45; Fig. 7; and col. 5, lines 1-25).

Ehrlich is deemed to be analogous as a secondary reference if it addresses the same problem as does the primary reference. See *In re GPAC Inc.*, 35 USPQ 2d 1117, 1120, 1121 (FC 1995).

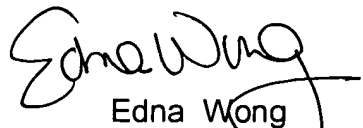
Furthermore, Vanlseghem teaches that the resist is exposed to the action of a particular etchant. Many variations of this basic etching process can be formed without departing from the spirit and scope of the invention since the steps can be rearranged to

suit a particular resist laminate construction and object to be etched (col. 9, lines 25-32).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (703) 308-3818. The examiner can normally be reached on Mon-Fri 7:30 am to 5:00 pm, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1495.


Edna Wong
Primary Examiner
Art Unit 1753

EW
September 26, 2003